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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,600	08/02/2006	Yuriy Sergeyevich Bilivitin	VO-772	3647
43419 7590 05/25/2010 PAULEY PETERSEN & ERICKSON 2800 WEST HIGGINS ROAD SUITE 365 HOFFMAN ESTATES, IL 60169				
			EXAMINER FELTON, MICHAEL J	
			ART UNIT 1791	PAPER NUMBER
			MAIL DATE 05/25/2010	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/587,600

Applicant(s)

BILIVITIN ET AL.

Examiner

MICHAEL J. FELTON

Art Unit

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 21, 24, 25, 35-38, 40 and 41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 21, 24, 25, 35-38, 40 and 41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1, 21, 24, 36, 37, 38, 40, and 41 have been considered but are moot in view of the new ground(s) of rejection.
2. Applicant's arguments filed 12/16/2009 with respect to claims 25 and 35 have been fully considered but they are not persuasive.
3. The applicant argues that the one of ordinary skill would not substitute the filter of Arneson as a means for separating tobacco from the cavity of Schut et al. The examiner disagrees. As can be seen in the invention of Arneson, the filter is designed to physically separate the tobacco from the mouth end structure (draw holes), providing a similar structure to that of Schut et al. (see figure 8, and col. 3, 40-48).

Claim Objections

4. Claim 24 and 36 are objected to because of the following informalities: Claim 24 is dependent on a canceled claim (claim 23). In the interest of compact prosecution, the examiner has examined claims 24 and 36 based on the assumption that the claims would be amended to be dependent on claim 1 (original claim 23 was dependent on claim 1). However, if claim 24 is amended to depend from claim 1, a double patenting objection must be made concerning claim 38 (see next paragraph) and if claim 36 is amended to depend from claim 1, a double patenting objection must be made concerning claim 41 (see below). Appropriate correction is required.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1, 36, 40 and 41 are rejected under 35 U.S.C. 103(a) as being obvious over Schut et al. (DE10044771 and English machine translation thereof) in further view of Ahern et al. (GB 2159386 A).

9. Regarding claims 1, 36 and 41, Schut et al. disclose a telescoping cigarette system where the inner sleeve (figures 1-5, element 1) serves as the empty mouthpiece, an empty outer sleeve envelope (element 2) that can slide (i.e. overlap the mouthpiece) so that the cavity within the envelope can be varied (i.e. so that at least part of a second cavity of the mouthpiece is detachable and movable from at least part of the cavity of the envelope). A perforated portion of the mouthpiece wall is crimped (i.e. a deformed part, or selectively penetrable partition) is shown by Schut et al. in figure 3 element 6, 6a, and 9, where it is shown blocking the tobacco (and allowing compression of the tobacco).

10. Schut et al. do not disclose or illustrate, "a portion of the end extending across the second cavity (3) and contacting the opposing inner side wall of the second cavity (3), wherein clearances are formed on sides of the deformed part (5) between the deformed part (5) and the inner side wall of the second cavity (3)." However, this arrangement is disclosed by Ahern et al. (see figure 12, element 318). Ahern et al. also provides motivation for using such a deformation and state, "One problem with the arrangement of Figure 6 is that it may not be possible to ensure that the flaps 12 are fully effective...It may therefore be necessary to provide indents or other obstructions, in order to prevent the fireball being drawn into the tube when the cigarette is smoked..." (page 4, 11-19; see also all of page 4). It would have been obvious to one of ordinary

skill in the art at the time of invention that the obstruction of Schut et al. (element 6), could be replaced with the obstruction disclosed in figure 12, that touches the opposite side of the tube and leaves a clearance on the sides of the deformed part.

11. Regarding claim 40, the empty mouthpiece and crimped paper tube of Schut et al. is inherently of a material with low sorption capability (i.e. air).

12. Claims 21, 25, and 35 are rejected under 35 U.S.C. 103(a) as being obvious over Schut et al. (DE10044771 and English machine translation thereof) and Ahern et al. (GB 2159386 A) as applied to claim 1 above, in further view of Labarre (US 905,715).

13. Regarding claim 21 and 25, Schut et al. and Ahern et al. do not disclose perforated partitions or perforated diaphragms to keep tobacco from entering the mouthpiece. However, Labarre discloses a perforated diaphragm designed to separate tobacco from the pipe portion of a pipe. It would have been obvious to one of ordinary skill in the art at the time of invention to use the perforations, or the perforated diaphragm of Labarre in the inventions of Schut et al. and Ahern et al. because Ahern et al. suggest that, "It may therefore be necessary to provide indents or other obstructions, in order to prevent the fireball being drawn into the tube when the cigarette is smoked" (page 4, 11-19) and Labarre teaches that the perforated partition, "for effectually[sic] preventing tobacco and nicotin[sic] from gaining access to and obstructing the bore of the pipe," (page 1, 12-14). It would have been obvious to one of ordinary skill that the structure used in the pipe of Labarre would be useful to meet the suggested function of Ahern et al.

14. Regarding claim 35, Schut et al. disclose a filter in the mouthpiece (element 4).
15. Claims 25 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schut et al. (DE10044771 and English machine translation thereof) in view of Arneson (US 2,542,612).
16. Schut et al. disclose a telescoping cigarette system where the inner sleeve (figures 1-5, element 1) serves as the empty mouthpiece, an empty outer sleeve envelope (element 2) that can slide (i.e. overlap the mouthpiece) so that the cavity within the envelope can be varied (i.e. so that at least part of a second cavity of the mouthpiece is detachable from at least part of the cavity of the envelope). A perforated portion of the mouthpiece wall is crimped (i.e. a deformed part, or selectively penetrable partition) is shown by Schut et al. in figure 3 element 6, 6a, and 9, where it is shown blocking the tobacco (and allowing compression of the tobacco).
17. Although Schut et al. disclose using a perforated, crimped separating partition, the use of alternative partitions is not disclosed. However, it would have been obvious to one of ordinary skill in the art to use other means to physically separate the tobacco from the cavity in the mouthpiece that is conventional in Russian cigarettes. For instance, Arneson teach the use of a filtering element to prevent passage of crumbs of tobacco into the smokers mouth, the same problem being solved by the crimped section disclosed by Schut et al. Therefore, it would have been obvious to use the filters disclosed by Arneson, such as the spiral filter shown in figures 3, 4, and 8, or the perforated diaphragm shown in figure 5, to separate the tobacco from the mouthpiece.

18. Claims 24, 37, and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schut et al. (DE10044771 and English machine translation thereof) and Ahern et al. (GB 2159386 A) as applied to claim 1 above, and Schut et al. (DE10044771 and English machine translation thereof), Ahern et al. (GB 2159386 A) and Labarre (US 905,715) as applied to claim 25, in further view of Labarre (US 905,715).

19. Schut et al. do not disclose a spacing insert. However, Edgar et al. disclose a tobacco cartridge and spacing insert (see abstract). It would have been obvious to one of ordinary skill in the art at the time of invention to use the tobacco cartridge and spacer of Edgar et al. in the cigarette of Schut et al. as the cigarette of Schut et al. does not contain tobacco and if a partial complement of tobacco was desired, the tobacco and spacer of Edgar et al. could be used.

Conclusion

20. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL J. FELTON whose telephone number is (571)272-4805. The examiner can normally be reached on Monday to Friday, 7:30 AM to 4:30 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Phillip C. Tucker can be reached on 571-272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 10/587,600
Art Unit: 1791

Page 9

/Michael J Felton/
Examiner, Art Unit 1791

/Philip C Tucker/
Supervisory Patent Examiner, Art Unit 1791